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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,369	11/06/2003	Marc S. Gorans	294.00170101	8480
26813	7590	08/12/2005	EXAMINER	
MUETING, RAASCH & GEBHARDT, P.A. P.O. BOX 581415 MINNEAPOLIS, MN 55458			VALENTI, ANDREA M	

ART UNIT PAPER NUMBER

3643

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/702,369	GORANS ET AL.
Examiner	Art Unit	
Andrea M. Valenti	3643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 14 June 2005.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-18 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 1-18 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ .

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

Allowable Subject Matter

The indicated allowability of claims 6-18 are withdrawn in view of the reference(s) to U.S. Patent No. 5,651,731 to Gorans et al in view of U.S. Patent No. 4,446,819 to Gourlandt and U.S. Patent application No. 10/346,981.

Rejections based on the newly cited reference(s) follow.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of copending Application No. 10/346,981 and claims 1-29 of U.S. Patent No. 5,651,731. Although the conflicting claims are not identical, they are not patentably distinct from each other because all teach at least one non-contact energy source for treating the lower beak of a bird with a head positioning device with an aperture. Merely, eliminating an element and its function i.e. a secondary energy director does not present a

patentably distinct limitation. Furthermore, merely pressing inward on the throat is an inherent step of inserting the bird into the head positioning device for a secure fit to reduce movement of the animal and thus reduce possible injury to the animal.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

Claims 11 and 15 are objected to because of the following informalities:

Claim 11, line 4, "device adapted to position" should be changed to –device positioned--

Claim 15, line 2, "device adapted to position" should be –device positioned--

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,651,731 to Gorans et al in view of U.S. Patent No. 4,446,819 to Gourlandt.

Regarding Claim 1, Gorans teaches a method of treating the beak of a bird, the method comprising: positioning a bird head in a bird head positioning device (Gorans Fig. 5 #22), wherein the bird head positioning device comprises first and second major

sides (Gorans Fig. 5 #69 and 68), and a beak receiving aperture formed through the first and second major sides of the bird head positioning device, wherein at least a portion of the lower beak of the bird head protrudes through the beak receiving aperture and is exposed proximate the second major side of the bird head positioning device; pressing inward on the throat of the bird proximate the base of the lower beak (Gorans Fig. 10 illustrates a hand pressing the bird inward to the device), wherein the pressing is directed towards the tongue of the bird (Gorans Fig. 5 lower portion of element #61 that comes in contact with element B inherently presses directed towards the tongue as the bird is pressed into the device); emitting energy from a non-contact energy source; and directing the energy emitted from the non-contact energy source at the second major surface of the bird head positioning device, wherein the energy is incident on the beak exposed proximate the second major side of the bird head positioning device while pressing inward on the throat of the bird (Gorans Col. 3 line 18-22)..

Gorans teaches treating the upper beak, but is silent on treating the lower beak. However, Gourlandt teaches it is old and notoriously well-known to treat either one or both beaks (Gourlandt Col. 5 line 52-55; U.S. Patent No. 4,343,310 to DuBose et al is not used in the rejection, but merely cited as an example of further teaching of general knowledge to one of ordinary skill in the field to remove a portion of either the upper beak, or the lower beak, or both Col. 2 line 30-45). It would have been obvious to one of ordinary skill in the art to modify the teachings of Gorans with the teachings of Gourlandt at the time of the invention since the modification is merely changing/shifting the application point of the energy source to an alternate location while performing the

same intended function modified to further reduce injury caused by the bird peaking other birds.

Regarding Claim 2, Gorans as modified teaches the pressing is performed while the bird head is positioned in the bird head positioning device (Gorans Fig. 10).

Regarding Claim 3, Gorans as modified teaches the pressing is performed after the bird head is positioned in the bird head positioning device (Gorans Fig. 10).

Regarding Claims 6 and 11, Gorans is silent on the bird head positioning device comprises a tongue control protrusion, wherein the tongue control protrusion presses into the throat of the bird proximate the base of the lower beak, but Gorans as modified by Gourlandt teaches the bird head positioning device comprises a tongue control protrusion, wherein the tongue control protrusion presses into the throat of the bird proximate the base of the lower beak (Gourlandt Col. 4 line 51-59). It would have been obvious to one of ordinary skill in the art to further modify the teachings of Gorans with the teachings of Gourlandt at the time of the invention to protect the tongue or to position the tongue in a particular location for treatment.

Regarding Claim 4, 5, and 7, Gorans as modified is silent on adjusting a force used to perform the pressing or limiting a force used to perform the pressing. However, it would have been obvious to one of ordinary skill in the art to further modify the teachings of Gorans at the time of the invention to prevent from causing injury to the bird and based on the size of the bird.

Regarding Claims 8 and 15, Gorans as modified teaches the tongue control protrusion extends into the beak receiving aperture (Gourlandt Fig. 6 and Col. 4 line 51-59).

Regarding Claims 9, 13 and 17, Gorans as modified is silent on explicitly teaching adjusting a distance by which the tongue control protrusion extends into the beak receiving aperture. However, it would have been obvious to one of ordinary skill in the art to further modify the teachings of Gorans at the time of the invention since the modification is merely making something adjustable while performing the same intended function, modified to accommodate different size birds. Making something adjustable does not present a patentably distinct limitation [*In re Stevens*, 212 F.2d 197, 198, 101 USPQ 284, 285 (CCPA 1954)].

Regarding Claims 10, 12 and 16, Gorans as modified teaches the tongue control protrusion extends into the beak receiving aperture by a fixed distance (Gourlandt Fig. 6 #62).

Regarding Claims 14 and 18, Gorans as modified teaches comprising a resilient member biasing the tongue control protrusion into the beak receiving aperture (Gorans #70).

Response to Arguments

Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

Claim 15 does not provide the limitation that the portion of the beak being treated is the lower portion. Examiner maintains that is known to treat the lower, the upper, or

both portions of a birds beak and merely selecting which portion of the beak to be treated with a known means of energy treatment is an obvious modification for one of ordinary skill in the art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea M. Valenti whose telephone number is 571-272-6895. The examiner can normally be reached on 7:00am-5:30pm M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 571-272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Andrea M. Valenti
Patent Examiner
Art Unit 3643

09 August 2005